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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,349	06/02/2006	Masanori Masuda	DK-US065117	4989

22919 7590 10/24/2007  
GLOBAL IP COUNSELORS, LLP  
1233 20TH STREET, NW, SUITE 700  
WASHINGTON, DC 20036-2680

EXAMINER
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TRIEU, THERESA

ART UNIT	PAPER NUMBER
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3748

MAIL DATE	DELIVERY MODE
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10/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/581,349

Applicant(s)

MASUDA, MASANORI

Examiner

Theresa Trieu

Art Unit

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Oct. 11, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 4 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 2, 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>June 2, 2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This Office Action is responsive to the applicants' election filed on Oct. 11, 2007.

#### *Election/Restrictions*

1. Applicant's election without traverse of the species of Figs. 1-4, claims 1 and 3-6 being readable thereon, in the reply filed on Oct. 11, 2007 is acknowledged.

Claims 2 and 7-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Oct. 11, 2007.

#### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "SCROLL COMPRESSOR HAVING A POSITION ADJUSTMENT DEVICE URGING THE MOVABLE SCROLL TOWARDS THE STATIONARY SCROLL BY MOVING A SEAL FORMED BETWEEN A SUPPORT AND THE MOVABLE SCROLL".

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3748

- Regarding claim 3, the phrase "capable of" is indefinite. The phrase has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

- Regarding claim 4, the use of alternative expression "the end plate of the first scroll or the second scroll is provided with a back pressure introduction path" renders the claims indefinite because the alternative choices are non-equivalent.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Barito et al. (Barito) (Patent Number JP 04-166690).

Regarding claims 1 and 3, as shown in Figs. 1-4, Barito discloses a scroll compressor comprising: a compressor mechanism including a first scroll 16 having an end plate and a spiral wrap 17 formed thereon and a second scroll 12 having an end plate and a spiral wrap 13 formed thereon and engaging with the first scroll; a support 30 for supporting the second scroll; a seal 26-28 arranged between the support and the second scroll; and a position adjustment device (read by the examiner as the magnetic/resilient seal) having for changing a position of the second scroll along an axial direction of the compressor mechanism, the seal 26-28 hermetically contacting the end plate of the second scroll 12 such that a back pressure space 34, 35 for

Art Unit: 3748

bringing the first scroll and the second scroll into contact with each other is defined inside the seal with the first and second scrolls 16, 12 being engaged, and the position adjustment is device being configured to change a position of the seal between a sealing position at which the seal hermetically contacts the end plate of the second scroll and a leakage position at which the seal is separated from the end plate of the second scroll; the first scroll 16 is a stationary scroll prohibited from revolving, and the second scroll 12 is a moving scroll moving with respect to the first scroll.

Regarding claim 4, Barito discloses the end plate of the second scroll 12 is provided with a back pressure introduction path 22, 23 for making the back pressure space communicate with a portion of a compressor chamber defined between the first scroll and the second scroll, the portion being more inside than a periphery of the compressor chamber.

***Allowable Subject Matter***

5. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Prior Art***

6. The IDS (PTO-1449) filed on June 2, 2006 has been considered. An initialized copy is attached hereto.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and consists of five patents: Arata et al. (U.S. Patent Number 4,596,520), Kimura et al. (U.S. Patent Number 6,872,063), Kuroki et al. (U.S. Patent Application Publication Number

Art Unit: 3748

2002-0039540), Nagamoto et al. (Publication Number JP 04-166690) and Kawabe (Publication Number JP 06-173864), each further discloses a state of the art.

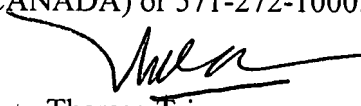
*Communication*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT  
October 22, 2007

  
Theresa Trieu  
Primary Examiner  
Art Unit 3748